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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,277	09/09/2003	Hideo Natori	00862.023217	1860
5514 7590 10/29/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER PARK, CHAN S	
			ART UNIT	PAPER NUMBER
			2625	
			MAIL DATE	DELIVERY MODE
			10/29/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/657,277	Applicant(s) NATORI, HIDEO	
	Examiner CHAN S. PARK	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-24, 29 and 33 is/are pending in the application.
- 4a) Of the above claim(s) 5, 15 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 11-14, 16-24, 29 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN  
PRIMARY EXAMINER

*Traveloute*

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20071015.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

*Chan S. Park*

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species I in the reply filed on 10/10/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The applicant elected Species I (claims 1-4, 6-8, 11-14, 16-23, 29 and 33). Since claims 5, 15 and 20 belong to Species II, these claims will be withdrawn from the consideration and will be not examined in the current Office Action. However, the examiner notes that claim 24 is readable on Species I and thus, it will be examined in the current Office Action.

### ***Claim Objections***

2. Claims are objected to because of the following informalities:

Claim 8, line 2, "so controls as to" should be -- controls so as to --.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 16 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 16 is drawn to functional descriptive

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material NOT claimed as residing on a computer readable medium. MPEP

2106.IV.B.1(a) (Functional Descriptive Material) states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized."

Also, refer to page 53 of the Interim Guideline.

Claim 16, while defining a computer program product, do not define a "computer-readable medium" and is thus non-statutory for that reason. A computer program product can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to state, "A computer-readable medium encoded with a computer program..." in order to make the claim statutory.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 8, 14, 16, 19 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4. Claim 1 recites the limitation “the basis of acquired preview display information” in line 9. There is insufficient antecedent basis for this limitation in the claim. It is unclear as to how and where this preview display information is acquired from.

5. Furthermore, it is unclear as to whether “the generated image data” is used for displaying the preview or printing the document data. Clarification/explanation from the Specification is respectfully requested.

6. With respect to claim 4, it recites the limitation of creating the bitmap data. It is unclear if this bitmap data is used for printing the image or displaying the preview of the image.

7. With respect to claim 8, it recites the limitation of generating the image data in accordance with a print start instruction and printing on the basis of the generated image data. It appears the image data is already generated based in response to issuing of the image generation request (claim 1). It is unclear as to which of the two generated image data (claim 1 & claim 8) is used for printing. Or are they simply the same?

8. With respect to claims 16, 19 and 23, arguments analogous to those presented for claims 1, 4 and 8, are applicable.

9. With respect to claim 14, it is unclear if “bitmap data” is same as the generated image data. If so, is the image data generated again based on the already created bitmap data? Clarification/explanation from the Specification is respectfully requested.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6, 8, 11, 12, 14, 16, 17, 19, 21, 23, 24 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakamura et al. U.S. Patent No. 6,791,709 (hereinafter Nakamura).

10. With respect to claim 1, Nakamura discloses a print control apparatus (fig. 2) having a function for temporarily saving output intermediate data (rendering instruction) of document data in accordance with a document data print instruction (user input via the input device 13), comprising:

an image data generator configured to generate image data (RGB image data for the preview display) on the basis of the temporarily saved intermediate data (col. 6, lines 1-28);

a previewer configured to, when display of a print image of the document data is designated by the print instruction, issue an image generation request (signal for activating the renderer 44) in accordance with the print instruction (col. 5, line 66 ~ col. 6, line 4), and displaying a preview window representing the print image of the

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document data on the basis of acquired preview display information (col. 6, lines 18-61);  
and

a processing controller configured to control said image data generator so as to generate the image data in response to issuing of the image generation request (col. 6, lines 1-27), notifying said previewer of the preview display information (resolution of the preview to be displayed in col. 6, lines 25-27) based on the generated image data, and thus controlling said previewer so as to display a preview representing the print image (col. 6, lines 18-61).

11. With respect to claim 2, Nakamura discloses the apparatus according to claim 1, wherein

the image generation request issued by said previewer includes designation information on a size or resolution of image data to be generated, and

said processing controller controls said image data generator so as to generate the image data at the size or resolution designated by the designation information (col. 6, lines 18-28).

12. With respect to claim 4, Nakamura discloses the apparatus according to claim 1, wherein the image generation request issued by said previewer includes the number of colors used for bitmap data stored in a print image file, or a subtractive process used to created the bitmap data (col. 6, lines 11-17 & col. 7, lines 4-32).

13. With respect to claim 6, Nakamura discloses the apparatus according to claim 1, wherein when said previewer issues an inquiry about whether print data to be printed is temporarily saved as intermediate data, said processing controller sends a reply to the

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inquiry (it is inherent that the user must inquire the presence of the print data in the host computer before sending the print job to the printer for print or preview).

14. With respect to claim 8, Nakamura discloses the apparatus according to claim 1, wherein said processing controller controls so as to generate the image data by said image data generator on the basis of the temporarily saved intermediate data in accordance with a print start request, and controls a printing apparatus so as to print on the basis of the generated image data (col. 5, lines 58-67).

15. With respect to claim 11, Nakamura teaches a print control method of displaying a preview representing a print image of document data in accordance with a document data print instruction (fig. 2), comprising:

a generation step of, when display of a print image of the document data is designated by the print instruction, causing image data generator to generate image data on the basis of output intermediate data (rendering instruction stored in the journal file) of temporarily saved document data in accordance with the instruction (fig. 4 & col. 6, lines 5-45); and

a display step of displaying the generated image data on a display (fig. 5 & col. 6, lines 5-45).

16. With respect to claim 12, Nakamura teaches the method according to claim 11, wherein in the generation step, the image data generator generates the image data at a designated size or resolution (col. 6, lines 18-27).



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17. With respect to claim 14, Nakamura teaches the method according to claim 11, wherein in the generation step, the image data generator generates the image data by a designated number of colors or a subtractive process used to create bitmap data (col. 6, lines 11-17 & col. 7, lines 4-32).

18. With respect to claims 16 and 24, arguments analogous to those presented for claim 1, are applicable.

19. With respect to claim 17, arguments analogous to those presented for claim 2, are applicable.

20. With respect to claim 19, arguments analogous to those presented for claim 4, are applicable.

21. With respect to claim 21, arguments analogous to those presented for claim 6, are applicable.

22. With respect to claim 23, arguments analogous to those presented for claim 8, are applicable.

23. With respect to claim 29, Nakamura teaches a printer driver preview method (fig. 2) of displaying a preview on the basis of print data which is supplied from an application (application 30) and spooled by a standard spool function of an operating system (col. 5, line 44 ~ col. 6, line 36).

Claim 33 is rejected under 35 U.S.C. 102(e) as being anticipated by Lavery et al. U.S. Patent No. 6,429,947 (hereinafter Lavery).

24. With respect to claim 33, Lavery teaches a print image preview method comprising:

a step of activating a previewer when a print processor is activated by a spooler (steps 902~910 of fig. 13);

a step of generating a preview file in accordance with a print image generation request from the activated previewer (col. 20, lines 28-35);

a step of writing image data in the generated preview file (note that the converted preview data is inherently written in the file since the file cannot be empty to display the preview); and

a step of reading out the image data from the preview file and displaying a preview (step 1212 in fig. 16).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura as applied to claims 1 and 6 above, and further in view of Yamaguchi et al. U.S. Patent Application Pub. No. 2003/0002056 (hereinafter Yamaguchi).

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25. With respect to claim 3, Nakamura discloses the apparatus according to claim 1, but it does not explicitly disclose that the image generation request includes page number information on a total number of pages of image data to be generated and said processing controller controls said image data generator so as to generate image data corresponding to a page number designated by the page number information.

Yamaguchi, the same field of endeavor of the print preview art, discloses a host computer including a previewer for displaying the total number of pages of image data and generating the preview for a corresponding page in the print job (fig. 12 & paragraph 125).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the displaying the total number of pages in the preview into the host computer of Nakamura.

The suggestion/motivation for doing so would have been to indicate the page number of the currently displayed page to the user.

Therefore, it would have been obvious to combine Nakamura with Yamaguchi to obtain the invention as specified in claim 3.

26. With respect to claim 7, Nakamura discloses the apparatus according to claim 1, but it does not explicitly disclose that said previewer issues an inquiry about a total number of pages in actually printing the target document data, said processing controller sends a reply to the inquiry.

Yamaguchi, the same field of endeavor of the print preview art, discloses a host computer including a previewer for displaying the total number of pages of image data by inquiring/retrieving the information for the print job file (fig. 12 & paragraph 125).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the displaying the total number of pages in the preview into the host computer of Nakamura.

The suggestion/motivation for doing so would have been to indicate the total number of pages to be printed to the user.

Therefore, it would have been obvious to combine Nakamura with Yamaguchi to obtain the invention as specified in claim 7.

27. With respect to claim 13, arguments analogous to those presented for claims 3 and 7, are applicable.

28. With respect to claim 18, arguments analogous to those presented for claim 3, are applicable.

29. With respect to claim 22, arguments analogous to those presented for claim 7, are applicable.

**Contact Information**

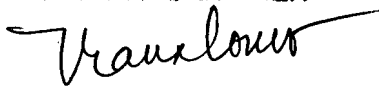
30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
October 16, 2007

**DOUGLAS Q. TRAN**  
**PRIMARY EXAMINER**



Chan S. Park  
Examiner  
Art Unit 2625

